



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,445	11/20/2000	Warren Adams	249768040US	2880

25096 7590 05/22/2003

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER

JASMIN, LYNDIA C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,445

Applicant(s)

ADAMS ET AL.

Examiner

Lynda C Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 ~~25-43~~ is/are pending in the application.
- 4a) Of the above claim(s) 1-24 ~~1-24~~ ⁴⁴⁻⁶⁶ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

Art Unit: 3627

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group IV (claims 25-43) in Paper No. 8 is acknowledged. The withdrawal of claims 1-24, 44-66 is also acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 25-28, 31, 33-39 and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Nelson et al. (2002/0042775 A1).

Nelson et al. discloses a method in a computing system and embodied in a computer-readable medium (102) for notifying a first user (registrant or recipient 110) about a purchase made by a second user (purchaser or guess 114), with the steps of:

detecting that the second user has purchased an item (via server computer 126 and via purchase transaction 138);

determining that the first user has a purchase notification relationship with the second user (via the server computer on which the purchase of a commodity is managed and by generating gift card; also see box 66); and

providing to the first user a notification that the second user has purchased the item (box 31, lines 16-21).

Nelson et al. also discloses a notification that the second user has purchased the item is provided to the first user by displaying a visual indication (via downloading list of purchasing items by the recipient) of the purchase on a Web page requested by the first user (via the site which oversees the purchase of the commodity).

Further, Nelson et al. a notification that the second user has purchased the item is provided to the first user by sending a message (electronic mail) to the first user (box 31, lines 20, 21), or sent message is a snail mail message (as for example a postal mail gift card) (box 56, lines 5).

Nelson et al. further includes the step of establishing for the first user a purchase notification relationship with the second user in response to an instruction from the second user (via purchase transaction 138), establishing for the first user a purchase notification relationship with the second user in response to an instruction from the first user (via creating a list made available on the server computer by the recipient), and establishing for the first user a purchase notification relationship with the second user in response to a comparison of characteristics of the first and second users (via recipients and purchasers) (boxes 29 and 30). The notification is only provided in response from authorization from the second user with respect to the item (box 56, lines 6 and 7). The notification includes a control for obtaining additional information about the product (via box 52). The notification includes a control for purchasing the product (via box 57). The

detecting includes receiving an order (via purchase transaction) from the second user for the item.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., in view of Ewing (202/0095298 A1).

Nelson et al discloses all the structural elements of the claimed invention both fail to explicitly disclose the common an well known variation of sending messages via instant message, pager message and voice mail message.

Ewing discloses the concept of having member interacting with other members over the internet using text, audio or voice chat; instant messaging; or, e-mail, and the member desires to send the other member a gift.

From this teaching of Ewing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify Nelson to include the different ways of sending notification message to another party as taught by Ewing in order to engage in real time conversation.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al.

As per claim 40, Nelson et al. fails to explicitly disclose receiving an order from a third user ordering the item as a gift for the second user. However, Nelson et al. discloses that a gift giver may choose to contact other individuals to initiate a pooling of resources to purchase an item. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Nelson et al. with the common and well-known method of purchasing a gift by a third user for a second user for the purpose of buying a pricey gift that the second user is enable to afford (as an example of parents buying gift for their children's friend).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

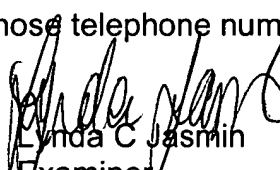
Business Wire "MyGiftList.com Announces Launch of Online Gift Registry" Dec 1999.

Dworkin (4,992,940), Robinson (5,884,282), Robinson (5,918,014), Jacobi et al. (6,317,722 B1) and Oshima (2003/0074265 A1) are cited as art of interest.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.


Lynda C Jasmin
Examiner
Art Unit 3627

lj
May 19, 2003